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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/053,387

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Jian Ling Ding

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03/05/2008

GREENBERG TRAURIG LLP (LA)
2450 COLORADO AVENUE, SUITE 400E
INTELLECTUAL PROPERTY DEPARTMENT
SANTA MONICA, CA 90404

EXAMINER

GHALI, ISIS A D

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

03/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/053,387	Applicant(s) DING ET AL.	
	Examiner Isis A. Ghali	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,5-8,10,13,16,18-32 and 35-39 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,5-8,10,13,16 and 18-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32 and 35-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The receipt is acknowledged of applicants' amendment filed 12/14/2007.

Claims 1, 4, 9, 11, 12, 14, 15, 17, 33 and 34 have been canceled.

Claim 39 has been added.

Claims 2, 3, 5-8, 10, 13, 16, 18-32, 35-39 are pending.

1. This application contains claims 2, 3, 5-8, 10, 13, 18-31 drawn to an invention nonelected with traverse in the reply filed on 03/12/2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01. Claim 16 has been withdrawn as directed to nonelected invention without traverse during telephone conversation with Mr. Wall on 09/12/2007.

Claims 32, 35-39 are included in the prosecution.

The following rejections have been overcome by virtue of applicants' amendment:

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The rejection of claims 33 and 34 under 35 U.S.C. 112, second paragraph, as being indefinite.

The rejection of claim 33 under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of US '525, US '026 and US '490, and further in view of US 6,805,961 (961).

The following new ground of rejection is necessitated by applicants' amendment:

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 32, 35-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 32 as amended has added new matter by reciting: "the hydrocolloid composition comprises about 95% to 30% PIB". Applicants refer to paragraph 0026 for support. Upon careful review to paragraph 0026, the paragraph describes the ratio between EPDM to PIB. Paragraph 0026 stated: "In one embodiment, the EPDM/PIB ratio ranges from about 5% EPDM and 95% PIB to about 70% EPDM and 30% PIB." Therefore, the 95% to 30% is not the concentration of the

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hydrocolloid composition as a whole that comprises EPDM, PIB and hydrophilic particles, it is the ratio of PIB to EPDM. In accordance to MPEP 714.02, applicant should specifically point out to where in the disclosure a support for any amendment made to the claims can be found.

The following rejection has been discussed in details in the previous office action, and is maintained for reasons of record:

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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6. Claims 32, 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of 5,827,525 ('525), US 4,335,026 ('026), and US 4,551,490 ('490).

US '525 teaches pressure sensitive adhesive capable for adhering to moist surfaces in the form of hydrocolloid adhesive comprising hydrophobic rubber in which 40-60% hydrophilic powders are dispersed. Hydrophobic adhesives included EPDM polymer, polyisobutylene and KRATON, which is SIS block copolymer, and hydrophilic powders included pectin and carboxymethyl cellulose (col.1, line 66 till col.2, line 18). US '525 teaches the adhesive comprises active agents (col.3, lines 4-6).

Although US '525 suggested each of EPDM polymer, polyisobutylene and KRATON as hydrophobic polymers, however, the reference does not explicitly teach their combination. US '525 does not explicitly teach the percentage of ethylene and propylene in the EPDM polymer.

US '026 teaches an adhesive composition for application to the skin as an adhesive bandage and tape having decreased resistance to peel removal while maintaining high shear resistance in air and in water (abstract; col.1, lines 7-11; col.3, lines 50-55). The preferred adhesive composition comprises ethylene-propylene-diene monomer terpolymer wherein the ratio of ethylene to propylene is 3:1, i.e. 75% ethylene and 25% propylene (col.2, lines 57-61). The composition further comprises, styrene block copolymer in an amount of 25-42%, elastomer stabilizer, pigments, and anti-oxidants, which read on the active agent (col.2, lines 20-33, 42-44; col.3, lines 30-33; col.5, lines 27-29; col.5, examples I-III).

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US '490 teaches medical grade adhesive resistant to erosion by moisture and body fluids, and it is non-irritating to the human skin (abstract; col.2, lines 28-36). The adhesive composition comprising 5-30% polyisobutylene, styrene block copolymers, hydrocolloid gums, elastomer, active agents and additives (col.2, lines 53-60; col.3, lines 9-11, 21-37, 47-65; col.4, lines 8-10, 18-21, 40-32, 56-60; col.5, lines 55-65).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide hydrocolloid adhesive composition comprising EPDM polymer and hydrophilic particles for adhering to moist surface as disclosed by US '525, and further add polyisobutylene, styrene block copolymer and elastomer as disclosed by US '490 motivated by the teaching of US '490 that adhesive composition comprising such elements is resistant to erosion by moisture and body fluids, non-irritating to the human skin, with reasonable expectation of having hydrocolloid adhesive composition comprising EPDM polymer, polyisobutylene, styrene block copolymer, elastomer and hydrophilic particles wherein the hydrocolloid adhesive composition is non-irritating to the skin and has enhanced adhesion to moist surfaces while resistant to erosion by moisture.

Additionally, one having ordinary skill in the art would have been motivated to use EPDM polymer that has the ratio of ethylene to propylene of 3:1 disclosed by US '026 in the composition produced by the combination of US '525 and US '490 because US '026 teaches that adhesive comprising EPDM polymer having this ratio of ethylene and propylene is preferred, and when combined with polyisobutylene and styrene block copolymers provides decreased resistance to peel removal while maintaining high shear

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resistance in air and in water, with reasonable expectation of having hydrocolloid adhesive composition comprising EPDM polymer having ratio of ethylene to propylene of 3:1, polyisobutylene, styrene block copolymer elastomer, and hydrophilic particles wherein the hydrocolloid adhesive composition is non-irritating to the skin and has enhanced adhesion to moist surfaces while resistant to erosion by moisture, and further has decreased resistance to peel removal while maintaining high shear resistance in air and in water.

Response to Arguments

7. Applicant's arguments filed 12/14/2007 have been fully considered but they are not persuasive. Applicants argue that US '490 does not teach the amount of PIB as instantly claimed, instead teaches 5-30%, and US '026 teaches filler up to 10% of silica and US 525 teaches particles range 40-60% while the present claim 32 requires 20-40% hydrophilic particles. Therefore, the amended claim 32 teaches limitations outside what taught by the prior art.

In response to these arguments, it is argued that the amount of PIB as instantly claimed and the amount disclosed by US '490 are overlapping since according to the present claim the amount of PIB can be 30% and according to US '490 the amount of PIB can be 30%; and the same regarding the hydrophilic particles that can be 40% according to the present claims, and also can be 40% according to US '525, therefore the amounts of hydrophilic particles disclosed by US '525 and instantly claimed are overlapping. The examiner is relying on US '525 for teaching the hydrocolloidal

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hydrophilic particles, and not relying on US '026 that teaches 10% silica. Therefore, the claimed ratios of PIB and hydrophilic particles are met by the combination of the references. It has been held that where the claimed ranges overlap or lie inside ranges disclosed by the prior art, a prima facie case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir.1990). It has been further held that a prima facie case of obviousness exists where the claimed ranges and the prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isis A. Ghali whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Isis A Ghali/
Primary Examiner, Art Unit 1611

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